



Docket No.: 244846US2

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



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RE: Application Serial No.: 10/699,674

Applicants: Atsushi AYABE, et al.

Filing Date: November 4, 2003

For: AUTOMATIC TRANSMISSION HAVING TORQUE  
CONVERTER WITH LOCKUP CLUTCH AND  
METHOD OF CONTROLLING SAME LOCKUP  
CLUTCH

Group Art Unit: 3663

Examiner: TO, T.

SIR:

Attached hereto for filing are the following papers:

#### ELECTION RESPONSE

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 244846US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
ATSUSHI AYABE, ET AL. : EXAMINER: TO, T.  
SERIAL NO: 10/699,674 :  
FILED: NOVEMBER 4, 2003 : GROUP ART UNIT: 3663  
FOR: AUTOMATIC TRANSMISSION :  
HAVING TORQUE CONVERTER WITH  
LOCKUP CLUTCH AND METHOD OF  
CONTROLLING SAME LOCKUP  
CLUTCH

ELECTION RESPONSE

COMMISSIONER FOR PATENTS  
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SIR:

In response to the Office Action dated July 15, 2005, Applicants elect Group I, corresponding to claims 1-6, for prosecution in the application.

The election of Group I is made with traverse, with at least respect to Group II. It is further noted that Group II should include not only claim 7, but also the apparatus claims 8 and 9.

Applicants respectfully submit that the Examiner has failed to carry his burden of showing that the combination claims 1-6 is distinct from the sub-combination claims 7-9. Claims 1-6 recite the combination of an automatic transmission whereas claims 7-9 recite the sub-combination of a control apparatus for an automatic transmission. In order to establish distinctness, the Examiner must provide evidence that the combination (automatic transmission system including a controller) claims 1-6 do not require the particulars of the

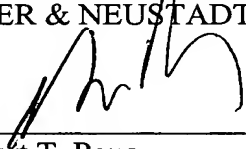
Application No. 10/699,674  
Reply to Office Action of July 15, 2005

sub-combination (control apparatus) claims for patentability. The Examiner has sought to carry this burden by pointing out limitations related to the sub-combination of the controller, e.g., that the controller is adapted to calculate the slip rotation speed of the lock-up clutch and control the hydraulic device so that the oil pressure of the lock-up clutch becomes constant if the slip rotation speed calculated is greater than a pre-determined rotation speed during a downshift of the automatic transmission. However, these are limitations related to the particulars of the sub-combination of the controller and so cannot establish that the particulars of the sub-combination are not required for patentability. The Examiner has therefore failed to carry his burden of establishing that the combination as claimed does not require the particulars of the sub-combination for patentability, and so it is respectfully requested that claims 7-9 also be examined in the above-referenced application.

Applicants also elect species A. Claims 1, 3, 4, 7, 9, 10, 12 and 13 correspond to species A. It is therefore requested that claims 1, 3, 4, 7 and 9 be examined in any subsequent Office Action.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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